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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,295

06/30/2004

Deborra J. Zukowski

F-870

4294

919 7590 07/06/2009

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EXAMINER

TRAN, TUYETLIEN T

ART UNIT

PAPER NUMBER

2179

NOTIFICATION DATE

DELIVERY MODE

07/06/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iptl@pb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,295	<b>Applicant(s)</b> ZUKOWSKI ET AL.	
	<b>Examiner</b> TUYETLIEN T. TRAN	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-23, 25-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the following communication: Amendment filed on 04/27/2009. **This action is made non-final.**
2. Claims 1-6, 13-23, 25-26 are pending in this case. Claims 1 and 15 are independent claims.

### **Continued Examination Under 37 CFR 1.114**

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/27/09 has been entered.

### **Claim Objections**

4. Claim 1 is objected to because of the following informalities: the term "the token" recited in line 11 of the claim should be changed to "the physical token" to be consistent with the language of the claim. Claim 1 is further objected to because it lacks the antecedent basis for the term "the user" recited in line 13 (note: "user selection data" is recited in line 10).
5. Claims 6 and 20 are objected to because of the following informalities: the term "the sensor" and "the token" should be changed to "the physical sensor" and "the physical token" to be consistent with the language of the claims.
6. Claim 13 is objected to because it lacks the antecedent basis for the term "placing the physical token in an instrumented association bin" (note: claim 1 is now amended to "sensing the presence of").

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7. Claim 15 is objected to because of the following informalities: the term “the sensor” recited in line 8 lacks the antecedent basis (e.g., it is not clear whether “the sensor” is referring to “a physical sensor” or “a sensor identifier”).

Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-6, 13, 14, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations “sensing a physical sensor in proximity to the physical token”. However, there is no description in the specification to support the above-mentioned limitations. The closest description can be found in Figure 7 and paragraph [0047] (e.g., PGpub US 2005/0273201 A1) where it states in part “The user attaches a sensor to the physical token”. This is not the same as “sensing a physical sensor in proximity to the physical token”. For the purpose of examination, the examiner will interpret the limitation as “attaching a physical sensor to the physical token”.

Claims 2-6, 13, 14, 25 are rejected as incorporating the deficiencies of the claim upon which it depends.

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**Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**11. Claims 1-6, 13-22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler III et al (Patent No. US 7089288 B2; hereinafter Gossweiler) in view of Thorman et al. (Pub. No. US 2005/0131959 A1; hereinafter Thorman).**

**As to claim 1,** Gossweiler teaches:

A method for processing a physical token in a responsive environment having a processor to provide an association with a virtual document (e.g., see Fig. 1) comprising:

sensing a physical sensor in proximity to the physical token, wherein the physical sensor is associated with the physical token (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna);

sensing the presence of the physical token in an instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between tag and tag reader occurs only when both are proximate; wherein the computer system having a plurality of card readers is interpreted as

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an instrumented association bin; note the card reader is affixed to a computational device included in the computer system);

Gossweiller further teaches associating a document with physical token in response to sensing the presence of the physical token in the instrumented association bin (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; wherein the user can be prompted to enter associated parameters via a dialog box or can navigate to the desired location);

Gossweiller further teaches obtaining user selection data identifying the virtual document to register with the token (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; where a text document can be associated with the identification number of the electronic tag);

Gossweiller teaches creating a sensor model instance associating the physical sensor with the physical token, the user and the virtual document using the processor (e.g., see 2:56-67 to 3:1-47, 6:14-36; 6:60-67; wherein each action is parameterized by a list of (name, value) pairs appropriate for that action, where the action can be linked to particular user, see 3:25-35);

While Gossweiller teaches the ability for the user to identify the virtual document to register with the token (e.g., see 6:14-36 and 6:60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiller does not teach launching a document browser application and obtaining user selection data from the document browser application to register with the token.

Thorman teaches a file browser that allows the user to identify files or documents for further manipulating (e.g., Figs. 4-5 and [0032]; wherein a file browser allow a user to easily identify files and directories). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the feature of allowing the user to identify a document to register with the token taught in Gossweiller to include the file browser feature as taught in Thorman to allow the user to select a document to register using a launching

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document browser. As suggested by Thorman, one would have been motivated to make such a combination is to make easier for the user to identify files or documents for further manipulating; thus, reduce the amount of time it takes the user to identify a document (e.g., see Thorman [0032]).

**As to claim 15, Gossweiller teaches:**

A method for processing a physical token in a responsive environment having a processor to provide an association with a virtual document (e.g., see Fig. 1) comprising:

placing a physical sensor having a sensor identifier in proximity to the physical token, wherein the physical token is associated with the physical token (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna; and wherein the coin or transponder includes an ID number);

placing the physical token in an instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between tag and tag reader occurs only when both are proximate; wherein the computer system having a plurality of card readers is interpreted as an instrumented association bin; note the card reader is affixed to a computational device), wherein the instrumented association bin is configured to read the sensor (e.g., see 2:21-38, 5:47-57; wherein the tag reader included in the computer system can read the tag's information);

obtaining sensor identifier data from the instrumented association bin (e.g., 2:21-38; wherein the tag reader receives the identification number and passes this on to the computer system as an ASCII string);

Gossweiller further teaches obtaining user selection data identifying the virtual document to register with the token (e.g., see 2:39-55, 5:47-67, 6:14-36 and 6:60-67; where a text document can be associated with the identification number of the electronic tag);

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Gossweiller teaches creating a sensor model instance associating the physical sensor with the physical token, the user and the virtual document using the processor (e.g., see 2:56-67 to 3:1-47, 6:14-36; 6:60-67; wherein each action is parameterized by a list of (name, value) pairs appropriate for that action, where the action can be linked to particular user, see 3:25-35);

While Gossweiller teaches the ability for the user to identify the virtual document to register with the token (e.g., see 6:14-36 and 6:60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiller does not teach launching a document browser application and obtaining user selection data from the document browser application to register with the token. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have made this combination for the same reasons as set forth in the rejection of claim 1.

**As to claims 2 and 16**, Gossweiller further teaches setting a sensor name property (e.g., see 5:47-57, 6:14-36).

**As to claims 3 and 17**, Gossweiller further teaches setting the sensor name property using an identifier associated with the document (e.g., see 5:58-67 to 6:1-13, 6:60-67).

**As to claims 4 and 18**, Gossweiller further teaches setting a sensor type property to indicate a physical sensor (e.g., see 6:60-67 to 7:1-13).

**As to claims 5 and 19**, Gossweiller further teaches setting a sensor class property to indicate touch detection (e.g., see 6:60-67 to 7:1-13).

**As to claims 6 and 20**, Gossweiller further teaches the sensor is attached to the token (e.g., see 2:9-20, 4:61-67).



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**As to claims 13 and 21**, Gossweiller further teaches wherein the physical token comprises a card (e.g., see 2:9-20; the tag) and placing the physical token in an instrumented association bin comprises placing the card and the physical sensor in the instrumented association bin (e.g., see Fig. 1 and 2:21-38, 5:47-57; communication between the electronic tag and tag reader occurs only when both are proximate; the card reader is affixed to a computational device in a computer system. The electronic tag comprises a card and coin unit with antenna).

**As to claims 14 and 22**, Gossweiller further teaches before placing the card and the physical sensor in the instrumented association bin, attaching the physical sensor to the card (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna; and wherein the coin or transponder includes an ID number).

**As to claims 25 and 26**, Gossweiller further teaches a plurality of physical tokens, wherein each of the plurality of physical tokens is each associated with one of a plurality of virtual documents (e.g., see 6:14-36).

**12. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler in view of Thorman further in view of Want et al. (published article, "Bridging Physical and Virtual Worlds with Electronic Tags"; CHI' 99; pages 370-377; hereinafter Want).**

**As to claim 23**, Gossweiller and Thorman teach the limitations of claim 15 for the same reasons as set forth above. Gossweiller further teaches wherein the sensor identifier comprises an first tag and the instrumented association bin comprises a tag reader, further comprising

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reading the sensor identifier data from the first tag using the tag reader (e.g., see 1:55-67 to 2:1-55; 5:47-57). Gossweiller and Thorman do not teach RFID tag and RFID reader.

In the same field of endeavor of physical and virtual worlds using electronic tags, Want teaches RFID tag and RFID reader (e.g., see pages 371, 372). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the electronic tag and tag reader as taught by Gossweiller and Thorman to include the feature of the RFID tag and RFID reader of Want to achieve the claimed invention. As suggested by Want, one would have been motivated to make such a combination is because RFID tags has no on-board power, thereby reducing the size and weight of the individual tags and eliminating maintenance requirements (e.g., see Want page 371, right column, "SYSTEM OVERVIEW").

### **Response to Arguments**

13. Applicant's arguments filed on 4/27/09 have been carefully considered but are not persuasive.

a) Applicant remarks with regard to claims 1 and 15 that the cited prior art of Gossweiller and Thorman do not teach or suggest "physical sensor associated with the user and a physical token" (e.g., see Applicant's remark page 7, paragraph 3).

In response, the examiner respectfully disagrees. Gossweiller discloses using an electronic identification tag to associate with virtual document such that the user can command to open a document (e.g., see 2:9-55, 6:14-36). Gossweiller discloses that the electronic identification tag comprises a card and a sensor (e.g., see 2:9-20, 4:61-67 to 5:1-9; wherein a small inductive coin with an antenna is attached to the tag; the tag cover is associated with the inductive coin and antenna). Therefore, Gossweiller clearly teaches the association between a physical sensor (e.g., inductive coin with an antenna) and a physical token (e.g., the tag cover

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or a card). Gossweiller further teaches a tag identification can be associated with semantic command (e.g., see 7:28-35) wherein the semantic command comprises the ones that can associated with a user (e.g., see 3:25-47, 6:14-36; open my computer desktop as I saved it a week ago). Therefore, Gossweiller teaches “physical sensor associated with the user and a physical token”.

b) Applicant remarks with regard to claims 1 and 15 that the cited prior art of Gossweiller and Thorman do not teach or suggest “a physical sensor associated with the particular token and virtual document so that it can report physical interaction such as touch applied to the token, but merely describe id tags and physical items” and “instrumented association bin” (e.g., see Applicant's remark page 7, paragraph 3).

In response, the examiner respectfully disagrees. Gossweiller teaches a command such as open or print a particular electronic document can be associated with a physical ID tag (e.g., col. 6 lines 14-36, lines 60-67). Gossweiller teaches the command associated with the ID tag can be identified using positional information, applied pressure, force utilized in squeezing a pressure sensor (e.g., col. 7 lines 1-13). Therefore, Gossweiller teaches the feature of associating a physical sensor with a particular token and virtual document. Gossweiller further teaches the feature of an instrumented association bin (e.g., col. 2 lines 21-38 and col. 5 lines 47-57; wherein the tag reader can write as well as read electronic tag identification numbers and data).

c) Applicant remarks with regard to claims 1 and 15 that the cited prior art of Gossweiller and Thorman do not teach or suggest “an instrumental association bin” (e.g., see Applicant's remark page 7, paragraph 3).

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In response, the examiner respectfully disagrees. As set forth in the rejection of claims 1 and 15, Gossweiler discloses a computer system 12 comprising a plurality of card readers affixed to each computer device (e.g., see Fig. 1 and 2:21-38, 5:47-57), which reads on the claimed limitation of an instrumented association bin because physical token (e.g., the electronic identification tag) can be sensed when it is near a computer device having a tag reader (e.g., see Fig. 1 and 2:21-38). Therefore, Gossweiler teaches an instrumented association bin.

For at least these reasons, the claims remain rejected over the cited prior art as rejected *supra*.

### **Conclusion**

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuyetLien (Lien) T. Tran whose telephone number is 571-270-1033. The examiner can normally be reached on Mon-Friday: 7:30 - 5:00, off on alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. T. T./

Examiner, Art Unit 2179

/Weilun Lo/

Supervisory Patent Examiner, Art Unit 2179